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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Yoshinori SHIBATA

Group Art Unit: 3724

Serial No.: 09/115,654

Examiner: C. Dexter

Filed: July 15, 1998

For: CIRCULAR SAW

RESPONSE TO OFFICE ACTION OF DECEMBER 31, 2001

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Honorable Director of
Patents and Trademarks
Washington, DC 20231

Sir:

The Office Action dated December 31, 2001, has been carefully reviewed in light of the Examiner's helpful comments and suggestions.

In the Office Action mailed September 9, 1999, the Examiner required the Applicant to elect one of six patentably distinct species. In Applicant's Response filed October 12, 1999, Applicant provisionally elected the species of Group IIb with traverse. Specifically, Group IIb concerned original claims 1, 12-15, and 17 drawn to a circular saw with both a first and second lock means and a specific sensor, classified in Class 83, Subclasses 471.2 and 522.15. The Examiner rejected our traverse in the Office Action mailed December 21, 1999, and made the species election requirement

final.

As an initial matter, Applicant notes that in the Office Action of September 9, 1999, the Examiner specifically stated that rejoinder of claims 2-11 would be considered, if claim 1 was elected and deemed allowable. However, until now, dependent claims 2-11 remain withdrawn from consideration. Therefore, the Examiner is respectfully reminded of his statement made in the September 9, 1999 Office Action and respectfully requested to examine claims 2-11 on the merit according to MPEP 809.02(c)(B)(1).

Further, Applicant wishes to note that in the Office Action mailed May 22, 2001, the Examiner indicated that claims 1, 12-19 and 21-34 appear to be allowable over the prior art. Because claim 1, for example, is much broader than the elected species of Group IIIb, the species election requirement appears to be moot at this stage. That is, because claim 1 contains allowable subject matter and is generic to all recited species (i.e., Groups Ia, Ib, IIa, IIb, IIIa, and IIIb), Applicant respectfully requests the Examiner to identify his legal basis for continuing to require an identification of which claims read upon the elected species, when his examination clearly shows that the species election was not required. The Examiner is referred to MPEP 809.02(d) and 809.02(e).

However, in order to expedite matters, Applicant provisionally notes that at least independent apparatus claims 33-35, 38, 40, 44, 48, 53 and 54 appear to read upon elected species IIIB. Furthermore, it is also believed that the remaining dependent claims 36-37, 39, 41-43, 45-47, and 49-50 also read upon the elected species IIIB, although due to the brevity of the Examiner's original species election requirement, Applicant can not be certain of the Examiner's intention. However, because independent claims 33-35, 38, 40, 44, 48, 53 and 54 are believed to be allowable and generic to dependent claims 36-37, 39, 41-43, 45-47 and 49-50, these dependent claims must be allowed if the generic independent claims are deemed allowable. MPEP 809.02(c)(B)(1). Therefore, no valid reason exists to withdraw the dependent claims from consideration in the event that the Examiner believes the one or more of the dependent claims do not read upon the species Group IIIB.

Further, new method claims 51 and 52 are also believed to read upon the elected species IIIB, because these method claims cover the method steps performed by the elected species IIIB. In addition or in the alternative, the Examiner is reminded that apparatus claims 53 and 54 serve as "linking" claims according to MPEP 809.03(C). Therefore, if claims 53 and 54 are deemed allowable, claims 51 and 52 must be examined

in this application in accordance with MPEP 809.03(C).

Each issue raised in the Office Action dated December 31, 2001, has been addressed and it is believed that the Amendment filed October 22, 2001, is now fully responsive to the prior Office Action mailed May 22, 2001. Wherefore, reconsideration and entry of the Amendment filed October 22, 2001, is respectfully requested.

Respectfully submitted,
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